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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,200	11/06/2001	Albert Dirnberger	16616-4	8061

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EXAMINER

ESTREMSKY, GARY WAYNE

ART UNIT PAPER NUMBER

3677

DATE MAILED: 07/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/993,200

Applicant(s)
Dirnberger

Examiner
Estremsky

Art Unit
3677



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 28, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 42-56 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 42-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Apr 29, 2003 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Drawings

1. The corrected or substitute drawings were received on April 12, 2003. These drawings are approved.

Specification

2. The incorporation of essential material in the specification by reference to a foreign application or patent (page 22, line 30 through page 23, line 2), or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first and second paragraphs of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 43, 44/43, 47, 48, 49/47, and 49/48 are rejected under 35 U.S.C. 112, first and second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01.

The written description beginning page 18, line 24 describes the claimed result (“constructed in such a manner that the,..., contact is lifted”) but does not describe or illustrate adequate structure in support thereof to allow one of ordinary skill in the art to make and use the claimed invention. The elements connecting the schematically shown elements required for performing the lifting are not shown or described.

The examiner notes that more complex embodiments are illustrated by the present disclosure but the disclosure does not include adequate written description of the operation of those embodiments. Assuming arguendo that description of the operation of the embodiments of Fig's 10-12 enables the claimed function, that description is considered ‘essential’ and cannot be incorporated by reference to a foreign application or patent.

And assuming, the embodiment of Fig's 10-12 can (and must be) be relied on for enablement, the claims are rejected as being incomplete for missing elements essential to operation as claimed. The omitted elements are: steering arm, guide arm, steering rod, crank pin, tensioning lever, opening arm, etc.. The only structure positively recited in the claim is “contacting surfaces”. As disclosed, the contacting surfaces cannot perform the recited function without

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additional elements; elements that are not positively recited or otherwise included as part of the claimed invention. The limitation cannot be given weight in accordance with 35 USC 112, 6th paragraph as covering the structure disclosed for performing the function (and equivalents). See MPEP 2181-2185. Accordingly, it is not clear what structure should be included within the scope of the claims and rejection under 35 USC 112, second paragraph is indicated.

The claim describes a result, but does not include the structure required to achieve the result. The claim, in effect, does not include 'the invention', i.e., the structure or 'means' required for achieving the functionally recited result and is in that respect, 'incomplete'.

5. Claims 42-44 and 50-56 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear what is included by limitation that "forces required during a transition from the closed position to the open position essentially correspond to forces required for a transition from the open position to the closed position.

Based upon the present disclosure and basic physics principles, correspondence between opening and closing forces does not include *exact* correspondence (largely due to small frictional losses in the bearings) and the limitation must be interpreted as covering some *range* of 'inexactness', where it is noted that the term 'essentially' does not include exact correspondence. The indefiniteness of the claim is in the actual limits of the range or extent of the inexactness in

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the correspondence that should be included, or not included within scope of the claimed invention cannot be reasonably determined, whereby one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

As example, it is noted that it appears that the functionally-recited 'result' of the claims ("essentially correspond to forces,...") is intended to differentiate the results of graph 2b from the results of graph 2a. But the examiner notes that lines II and III of graph 2b are not identical (i.e., do not, and can not have *identical* correspondence) and in that respect the difference between the result illustrated in graph 2b and the result illustrated in graph 2a (depicting prior art) is relative. One of ordinary skill in the art cannot reasonably determine the scope of the invention. Here it's noted that the limitation is functionally recited and does not appear to define any specific structure of the invention. See MPEP 2114.

Additionally regarding claim 44/42, 'as best understood' all limitations of that claim are recited by independent claim 42 whereby double inclusion confuses the scope and meaning of the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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7. Claims 42-49 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 2,833,578 to Burke.

Burke '578 teaches Applicant's claim limitations including : "contacting surfaces" - 36,37,15 that are inherently capable of operation as recited in the claim. The roller structure reads on limitation of "means of a bearing" and reduces friction whereby opening and closing forces have a correspondence with each other. Preamble recitation of intended use carries little patentable weight as regards further defining the "door lock" that is claimed as the invention.

It has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951).

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

As regards claim 43 for example, examiner recognizes that the reference does not illustrate structure for lifting the contact between the bolt 24 and keeper 15, but does disclose 'contacting surfaces that *are constructed in such a manner* that the contact between the contacting surfaces displaceable relative to one another can inherently be lifted' by intervention of the operator through insertion of a tool, etc. whereby friction can be reduced during opening movement. In

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that respect, the structure of the reference reads identically on the claimed invention which has contacting surfaces that can be lifted but does not include any particular structure for causing lifting. Examiner notes that this is not a 'process of using' claim (including a 'step' of lifting) and is not a 'product' and 'process of using' in a single claim. See MPEP 2173.05 (p) sections I and II as regards such claims. The limitation is functionally-recited and indefinite for the reasons noted in rejections made under 35 USC 112 and is being treated 'as best understood' as reciting a capability for the purpose of examination. See MPEP 2173.06.

As regards claims 45 and 46 for example, the limitations defining "gripping device" and "contact region" are broad enough that either can be properly read on the bearing means (15) of the reference.

As regards claim 47 for example, the bolt of the reference is inherently 'able to be displaced' (as noted above) that the active and contact regions are lifted. It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

As regards claim 49, part 15 reads on limitation of "means of a bearing".

8. Claims 42-53, 55 and 56 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 5,305,969 to Odell.

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Odell '969 teaches Applicant's claim limitations including : "contacting surfaces" - including 92,98 that are inherently capable of operation as recited in the claim. The roller structure reads on limitation of "means of a bearing" and reduces friction whereby opening and closing forces have a correspondence with each other. Widely accepted meaning of the term "corresponds to" is broad unless the type of correspondence is further defined in the claim. Applicant is advised that, while free to describe specific elements of the invention using broad terms in the written specification, later use of those broad terms in the claims does not provide for improperly importing specific but unstated limitations into the claims, particularly where such use might be repugnant to the accepted use and meaning of the term in question.

As regards claim 50, Odell '969 teaches a "frame" - 22, a closing lever" - including 96,38, "steering arm" - 44, and "tensioning lever" - including 45,42.

Examiner notes that the guiding movement of the linkage assembly lifts the contacting surfaces to follow a tangential path whereby "the mechanical efficiency of the lifting motion theoretically approaches infinity" as stated at col 16.

Allowable Subject Matter

9. Claim 54/50 and 54/52 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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Response to Arguments

10. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection. Since at least some of the rejections made under 35 USC 112 were not strictly necessitated by Applicant's amendment, this Office Action is not made Final in order to provide opportunity for Applicant to properly address these issues.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. U.S. Pat. No. 2,158,983 to Knoll.
- b. U.S. Pat. No. 2,240,400 to Johnson.
- c. U.S. Pat. No. 2,349,301 to Overby.
- d. U.S. Pat. No. 4,576,405 to Wartian.
- e. U.S. Pat. No. 4,913,476 to Cook.
- f. U.S. Pat. No. 5,642,909 to Swan.

12. Submission of any response by facsimile transmission is encouraged. Group 3677's relevant facsimile numbers are :

- 703-872-9326, for formal communications for entry **before Final** action: or
- 703-872-9327, for formal communications for entry **after Final** action.

Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly within our examining group and will eliminate Post Office processing and delivery time and will bypass the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see MPEP 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a Deposit Account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitted by facsimile transmission separately from the check.

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Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) ____ - ____) on _____
(Date)

Typed or printed name of person signing this certificate:

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Estremsky whose telephone number is (703) 308 - 0494. The examiner can normally be reached on M - Th from 730 am to 600 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann, can be reached on (703) 306-4115.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

- Technology Center 3600 Customer Service is available at 703-308-1113.

- General Customer Service numbers are at 800-786-9199 or 703-308-9000.

GWE
July 17, 2003


GARY ESTREMSKY
PRIMARY EXAMINER